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23550 7590 06/22/2010 HOFFMAN WARNICK LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207			EXAMINER CAMPBELL, JOSHUA D	
			ART UNIT 2178	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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PTOCommunications@hoffmanwarnick.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/709,433	<b>Applicant(s)</b> STEWART ET AL.	
	<b>Examiner</b> JOSHUA D. CAMPBELL	<b>Art Unit</b> 2178	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-16, 20-27 and 31-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-16, 20-27 and 31-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is responsive to communications: Amendment filed 2/25/2010.
2. Claims 12-16, 20-27, and 31-43 are pending in this case. Claims 12, 20, 24, 31, 37, 41, and 42 are independent claims. Claims 12, 20, 23-26, 31, 35, 37, 40, 42, and 43 have been amended.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claim 41 remains rejected under 35 U.S.C. 102(e) as being anticipated by Tonkin (US Patent Number 6,134,568, filed October 30, 1998).

**Regarding dependent claim 41**, Tonkin discloses a preview area for displaying a preview of a configured copy of a document wherein the preview is based on a print file and configuration information for the document which includes at least one printing option and defines how to assemble a printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). Tonkin discloses a navigation area that enables a user to select a portion of the preview displayed in the preview area, and an estimate area for displaying the price estimate for the configured copy based on the print file and configuration information (column 12, line 23-column 13, line 51 of Tonkin). Tonkin also discloses a configuration area which allows the user to alter the configuration information, which is automatically reflected in the preview of the document (column 7, lines 11-46 of Tonkin).

### ***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 37, 38, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamske et al. (US Patent Number 6,615,234, filed on May 11, 1999).

**Regarding independent claim 37**, Adamske discloses a method in which a user uses software on a client device to generate a print file by requesting to generate it which is identified by a unique identifier (the file name) and uploads it to a server or a print file may be generated on a server based on a document and a print driver (column

5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface (configuration graphical user interface) provides a printing options section that allows a user at the client device to provide configuration information including finishing and binding options that define how to assemble the printed copies (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). A plurality of copies are printed and assembled in accordance with the configuration information (column 5, line 64-column 7, line 56 of Adamske).

**Regarding independent claim 38,** Adamske discloses a method in which a user uses software on a client device to generate a print file by requesting to generate it which is identified by a unique identifier (the file name) and uploads it to a server or a print file may be generated on a server based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface (configuration graphical user interface) provides a printing options section that allows a user to provide configuration information including finishing and binding options that define how to assemble the printed copies (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). A plurality of copies are printed and assembled in accordance with the configuration information (column 5, line 64-column 7, line 56 of Adamske).

**Regarding dependent claim 40**, Adamske discloses a method in which a print drive is installed on the client in order to generate the print file (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a print driver is installed on the client and a print file is generated using the print driver, at which point the print file is uploaded to the server (column 5, line 64-column 7, line 15 of Adamske).

Adamske discloses a method in which the print driver necessary is automatically selected (column 5, line 64-column 7, line 15 of Adamske). Adamske does not disclose a method in which the print driver is listed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed to have listed the print driver of Adamske because it would have allowed the user to see the format type the print file would be in.

7. Claims 12-16, 20-27, 31-36, 39, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamske et al. (US Patent Number 6,615,234, filed on May 11, 1999) in view of Tonkin (US Patent Number 6,134,568, filed October 30, 1998).

**Regarding independent claim 12 and dependent claims 32 and 33**, Adamske discloses a method in which a user uses software on a client device to generate a print file based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file to the server, this print file (PostScript) being capable of being directly printed by a printer (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface (configuration wizard) is generated that may be web based (on the server) (column 2, lines 4-60 of

Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). Adamske discloses that the user is prompted to both configure and preview the copy of the document in the browser (column 6, line 58-column 7, line 15 of Adamske). Adamske does not directly disclose in this embodiment that a preview is generated by the server and provided to the user based on the print file that was uploaded. However, Adamske discloses an alternate method in which the server generates a preview based on the print file and the configuration information and provides that preview to the user for display at the client device (column 5, line 64-column 7, line 15 of Adamske). It would have been obvious to one of ordinary skill in the art to combine the two methods of Adamske because it would have allowed the client system to do less work in the process.

Additionally, Adamske does not explicitly disclose that the configuration information obtained before the preview is generated contains finishing and binding (bound copy) options which the preview is based on. However, Tonkin discloses that a print preview of a document is generated based on configuration information which includes binding and finishing options for a printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Adamske with the teachings of Tonkin because it would have allowed a

review of what the fully assembled document would like to help avoid any miscommunications between the author and the assembler.

**Regarding dependent claim 13**, Adamske discloses a method in which a print driver is installed on the client in order to generate the print file (column 5, line 64-column 7, line 15 of Adamske).

**Regarding dependent claim 14**, Adamske discloses a method in which a print driver is installed on the client and a print file is generated using the print driver, at which point the print file is uploaded to the server (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which the print driver necessary is automatically selected (column 5, line 64-column 7, line 15 of Adamske). Adamske does not disclose a method in which the print driver is listed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed to have listed the print driver of Adamske because it would have allowed the user to see the format type the print file would be in.

**Regarding dependent claim 15**, Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske).



**Regarding dependent claim 16**, Adamske discloses a method in which styles and printing options for the document are obtained and shown via the preview, which is then provided to the client (column 5, line 64-column 7, line 56 of Adamske).

**Regarding independent claim 20 and dependent claims 21-23**, the claims incorporate substantially similar subject matter as claims 12-15. Thus, the claims are rejected along the same rationale as claims 12-15.

**Regarding independent claim 24**, Adamske discloses a method in which a user uses software on a client device to generate a print file based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file to the server, this print file (PostScript) being capable of being directly printed by a printer (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section printing options section that allows a user to provide configuration information including finishing and binding options that define how to assemble the printed copies (column 7, lines 16-56 of Adamske). Adamske discloses that the user is prompted to both configure and preview the copy of the document in the browser (column 6, line 58-column 7, line 15 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). A plurality of copies are printed and assembled in accordance with the configuration information (column 5, line 64-column 7, line 56 of Adamske). Adamske does not directly disclose in this embodiment that a preview is generated by the server and provided to the user based on the print file that

was uploaded. However, Adamske discloses an alternate method in which the server generates a preview based on the print file and the configuration information and provides that preview to the user for display at the client device (column 5, line 64-column 7, line 15 of Adamske). It would have been obvious to one of ordinary skill in the art to combine the two methods of Adamske because it would have allowed the client system to do less work in the process.

Additionally, Adamske does not explicitly disclose that the configuration information obtained before the preview is generated contains finishing and binding (bound copy) options which the preview is based on. However, Tonkin discloses that a print preview of a document is generated based on configuration information which includes binding and finishing options for a printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Adamske with the teachings of Tonkin because it would have allowed a review of what the fully assembled document would like to help avoid any miscommunications between the author and the assembler.

**Regarding dependent claim 25**, Adamske discloses a method in which a user uses software on a client device to generate a print file and uploads it to a server or a print file may be generated on a server based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that

allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). A plurality of copies is printed in accordance with a plurality of addresses that are obtained from the user (column 5, line 64-column 7, line 15 of Adamske). A coversheet and shipping label (memo) is customized for each address and recipient is printed; at point all parts are delivered to the delivery addresses provided by the client (column 7, lines 16-56 of Adamske).

**Regarding dependent claim 26**, Adamske discloses a method in which payment information is obtained for the copy and the payment is processed using that information (column 6, line 58-column 7, line 15 of Adamske).

**Regarding dependent claim 27**, Adamske discloses a method in which the print driver generates the print file and an upload manager communicates the file to the server (column 5, line 64-column 7, line 15 of Adamske).

**Regarding independent claim 31**, Adamske discloses a method in which a user uses software on a client device to generate a print file based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file to the server, this print file (PostScript) being capable of being directly printed by a printer (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface (configuration wizard) is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The

interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). Adamske discloses that the user is prompted to both configure and preview the copy of the document in the browser (column 6, line 58-column 7, line 15 of Adamske). Adamske does not directly disclose in this embodiment that a preview is generated by the server and provided to the user based on the print file that was uploaded. However, Adamske discloses an alternate method in which the server generates a preview based on the print file and the configuration information and provides that preview to the user for display at the client device (column 5, line 64-column 7, line 15 of Adamske). It would have been obvious to one of ordinary skill in the art to combine the two methods of Adamske because it would have allowed the client system to do less work in the process.

Additionally, Adamske does not explicitly disclose that the configuration information obtained before the preview is generated contains finishing and binding (bound copy) options which the preview is based on. However, Tonkin discloses that a print preview of a document is generated based on configuration information which includes binding and finishing options for a printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Adamske with the teachings of Tonkin because it would have allowed a review of what the fully assembled document would like to help avoid any miscommunications between the author and the assembler.

**Regarding dependent claim 34**, Adamske discloses a method in which a user uses software on a client device to generate a print file based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file to the server, this print file (PostScript) being capable of being directly printed by a printer (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface (configuration wizard) is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). Adamske discloses that the user is prompted to both configure and preview the copy of the document in the browser (column 6, line 58-column 7, line 15 of Adamske). Adamske does not directly disclose in this embodiment that a preview is generated by the server and provided to the user based on the print file that was uploaded. However, Adamske discloses an alternate method in which the server generates a preview based on the print file and the configuration information and provides that preview to the user for display at the client device (column 5, line 64-column 7, line 15 of Adamske). It would have been obvious to one of ordinary skill in the art to combine the two methods of Adamske because it would have allowed the client system to do less work in the process.

Additionally, Adamske does not explicitly disclose that the configuration information obtained before the preview is generated contains finishing and binding

(bound copy) options which the preview is based on. However, Tonkin discloses that a print preview of a document is generated based on configuration information which includes binding and finishing options for a printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Adamske with the teachings of Tonkin because it would have allowed a review of what the fully assembled document would like to help avoid any miscommunications between the author and the assembler.

**Regarding dependent claim 35,** Adamske discloses a method in which a user uses software on a client device to generate a print file based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file to the server, this print file (PostScript) being capable of being directly printed by a printer (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section printing options section that allows a user to provide configuration information including finishing and binding options that define how to assemble the printed copies (column 7, lines 16-56 of Adamske). Adamske discloses that the user is prompted to both configure and preview the copy of the document in the browser (column 6, line 58-column 7, line 15 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). A plurality of copies are printed and assembled in accordance with the configuration information (column 5, line 64-column

7, line 56 of Adamske). Adamske does not directly disclose in this embodiment that a preview is generated by the server and provided to the user based on the print file that was uploaded. However, Adamske discloses an alternate method in which the server generates a preview based on the print file and the configuration information and provides that preview to the user for display at the client device (column 5, line 64-column 7, line 15 of Adamske). It would have been obvious to one of ordinary skill in the art to combine the two methods of Adamske because it would have allowed the client system to do less work in the process.

Additionally, Adamske does not explicitly disclose that the configuration information obtained before the preview is generated contains finishing and binding (bound copy) options which the preview is based on. However, Tonkin discloses that a print preview of a document is generated based on configuration information which includes binding and finishing options for a printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Adamske with the teachings of Tonkin because it would have allowed a review of what the fully assembled document would like to help avoid any miscommunications between the author and the assembler.

**Regarding dependent claim 36,** Adamske discloses that the user is prompted to both configure and preview the copy of the document in the browser (column 6, line 58-column 7, line 15 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske).

**Regarding dependent claim 39**, Adamske discloses a method in which a user uses software on a client device to generate a print file and uploads it to a server or a print file may be generated on a server based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). Adamske also discloses a method in which a user interface is generated that may be web based (on the server) (column 5, line 64-column 7, line 15 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 5, line 64-column 7, line 56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). Adamske also discloses a method in which styles and printing options for the document are obtained and shown via the preview, which is then provided to the client (column 7, lines 16-56 of Adamske).

Additionally, Adamske does not explicitly disclose that the configuration information obtained before the preview is generated contains finishing and binding options which the preview is based on. However, Tonkin discloses that a print preview of a document is generated based on configuration information which includes binding and finishing options for a printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Adamske with the teachings of Tonkin because it would have allowed a review of what the fully assembled document would like to help avoid any miscommunications between the author and the assembler.



**Regarding independent claim 42**, Adamske discloses a method in which a user uses software on a client device to generate a print file based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file to the server, this print file (PostScript) being capable of being directly printed by a printer (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface (configuration wizard) is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). Adamske discloses that the user is prompted to both configure and preview the copy of the document in the browser (column 6, line 58-column 7, line 15 of Adamske). Adamske does not directly disclose in this embodiment that a preview is generated by the server and provided to the user based on the print file that was uploaded. However, Adamske discloses an alternate method in which the server generates a preview based on the print file and the configuration information and provides that preview to the user for display at the client device (column 5, line 64-column 7, line 15 of Adamske). It would have been obvious to one of ordinary skill in the art to combine the two methods of Adamske because it would have allowed the client system to do less work in the process.

Additionally, Adamske does not explicitly disclose that the configuration information obtained before the preview is generated contains finishing and binding

(bound copy) options which the preview is based on. However, Tonkin discloses that a print preview of a document is generated based on configuration information which includes binding and finishing options for a printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Adamske with the teachings of Tonkin because it would have allowed a review of what the fully assembled document would like to help avoid any miscommunications between the author and the assembler.

8. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adamske et al. (US Patent Number 6,615,234, filed on May 11, 1999) in view of Tonkin (US Patent Number 6,134,568, filed October 30, 1998), further in view of Konica Minolta (hereinafter KM, " QMS Printing Notes for Windows Applications," published June 20, 1995).

**Regarding dependent claim 43,** Adamske discloses a method in which the document may be generated on the client and obtained from the client based on a program installed on a client including a print driver (column 5, line 64-column 7, line 15 of Adamske). Adamske does not explicitly disclose that an entry is added to a list of available printers for the clients in response to installing the print driver program. However, KM discloses the notoriously well-known teaching that when a print driver (like the PostScript driver found in the program of Adamske) is installed an entry is added to a list of available (installed printers) for the client (page 2, items "6." and "7." of

KM). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Adamske and Tonkin with the notoriously well known teachings of KM because it would have allowed users to easily access previously installed printers.

### ***Response to Arguments***

9. Applicant's arguments filed 2/25/2010 have been fully considered but they are not persuasive.

Regarding applicant's arguments on pages 14-15, in reference to independent claim 41 specifically referring to whether or not the Tonkin reference teaches concurrently displaying the different display areas in a GUI, the examiner respectfully disagrees. The limitation in question states, "...generating content for a display area of the graphical user interface, wherein the display area concurrently includes..." and then defines multiple areas which are to be included. The Tonkin reference teaches a preview area for displaying a preview of a configured copy of a document wherein the preview is based on a print file and configuration information for the document which includes at least one printing option and defines how to assemble a printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). Tonkin discloses a navigation area that enables a user to select a portion of the preview displayed in the preview area, and a estimate area for displaying the price estimate for the configured copy based on the print file and configuration information (column 12, line 23-column 13, line 51 of Tonkin). Tonkin also discloses a configuration area which

allows the user to alter the configuration information, which is automatically reflected in the preview of the document (column 7, lines 11-46 of Tonkin). The applicant appears to be arguing that because the Figures of Tonkin show different windows for performing tasks, the windows can not be displayed concurrently. All of the elements disclosed by the figures of Tonkin (specifically Figures 5, 8, and 9) are windows that exist as a part of the main graphical user interface (column 3, lines 15-31 of Tonkin). By definition windows are a part of a graphical user interface that encompass a portion of the screen that allow many different items to be displayed on the screen concurrently (see the definition of "window" provided from the Microsoft Press Computer Dictionary, published in 1993). The applicant is not allowed to redefine terms of the art, which includes the term "window" which is used in the Tonkin reference in line with the definition of the term in the art. Thus, when interpreting the term "window" in the Tonkin reference the examiner is forced to interpret it just as it is defined. Thus, the rejection remains proper and must be maintained.

Regarding applicant's arguments on pages 15-17, in reference to independent claim 37 specifically referring to whether or not the Adamske reference first limitation of the claim, the examiner respectfully disagrees. Adamske discloses a method in which a user uses software on a client device to generate a print file by requesting to generate it which is identified by a unique identifier (the file name) and uploads it to a server or a print file may be generated on a server based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). The applicant appears to be arguing that the limitation that specifically states, "...initiate transmitting the print file from the client to the

server in response to the generation of the print file and without user-initiated interaction the server” is not being met because the user must send the metafile to the translation server for conversion into a printable version (see final paragraph on page 17 of the applicant’s arguments). There are two major flaws in the applicant’s arguments. First, the printable version of the file is created at the client as taught by the Adamske reference. The applicant continually argues this not to be true, yet has made no actual response to the BPAI’s decision of this teaching to be true. Thus, for both the examiner and office’s position on this the examiner recommends the applicant consult the decision mailed on June 18, 2008 because the examiner will not provide any further response to this argument. Second, the applicant believes that the transmission of the printable file in Adamske requires “user-initiated interaction with the server,” which is entirely incorrect. The user of the client software only interacts with the client software, the actual transmission of the file from the client to the server is done at the user’s request to the client software but the user has no actual interaction with the server (column 5, line 64-column 7, line 15 of Adamske). The applicant appears to be implying that the phrase “user-initiated interaction with the server” should be interpreted as any user action, but the examiner does not have the liberty to interpret claims outside of the broadest most reasonable interpretation, which in this case is literally the phrase itself, with no user-initiated interaction with the server. Thus, once again the rejection is proper and must be maintained.

Regarding applicant’s arguments on pages 18-19, in reference to independent claim 12 specifically referring to whether or not the Adamske reference first limitation of

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the claim, the examiner respectfully disagrees. Adamske discloses a method in which a user uses software on a client device to generate a print file based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file to the server, this print file (PostScript) being capable of being directly printed by a printer (column 5, line 64-column 7, line 15 of Adamske). The arguments here are based on the same principles as claim 37, the print file is not generated at the client and the phrase "user-initiated interaction with the server" has a different meaning than the actual phrase itself. Once again, there are two major flaws in the applicant's arguments. First, the printable version of the file is created at the client as taught by the Adamske reference. The applicant continually argues this not to be true, yet has made no actual response to the BPAI's decision of this teaching to be true. Thus, for both the examiner and office's position on this the examiner recommends the applicant consult the decision mailed on June 18, 2008 because the examiner will not provide any further response to this argument. Second, the applicant believes that "user-initiated interaction with the server," is required in Adamske which is entirely incorrect. The user of the client software only interacts with the client software, the actual transmission of the file from the client to the server is done at the user's request to the client software but the user has no actual interaction with the server only with the client software (column 5, line 64-column 7, line 15 of Adamske). The applicant appears to be implying that the phrase "user-initiated interaction with the server" should be interpreted as any user action, but the examiner does not have the liberty to interpret claims outside of the broadest most reasonable interpretation, which in this case is literally the phrase itself,

with no user-initiated interaction with the server. Thus, once again the rejection is proper and must be maintained.

Regarding applicant's arguments on pages 19-22, in reference to all other claims, the applicant is asserting that because the previously argued claims/issues are believed to be true, the same applies for all other claims. Thus, the arguments are rebutted along the same rationale as found above for claims 12, 37, and 41.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA D. CAMPBELL whose telephone number is (571)272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joshua D Campbell/  
Primary Examiner, Art Unit 2178  
May 25, 2010